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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/773,393
Filing Date: January 31, 2001
Appellant(s): GOODKNIGHT, GREGORY WARREN

Julie L. Reed
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 28 February 2008 appealing from the Office action mailed 13 September 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

"Series V: Data Communications Over the Telephone Network," ITU-T V.8 bis, 1999, pp. 1-49.
ITU-T V.8 bis 09/98, "Series V: Data Communication Over the Telephone Network," 1999, pp. 1-49.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 22-31 are rejected under 35 U.S.C. 102(a) as being anticipated by “Series V: Data Communication Over the Telephone Network,” ITU-T V.8 bis, 1999, hereinafter Referred to as ITU-T.

This rejection is set forth in a prior Office Action, filed 12 September 2007, and is included below for the Board’s convenience.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22-31 are rejected under 35 U.S.C. 102(a) as being anticipated by “Series V: Data Communication Over the Telephone Network,” ITU-T V.8 bis, 1999, hereinafter Referred to as ITU-T.

Regarding claims 22 and 27, ITUT discloses the procedures for the identification and selection of common modes of operation between data circuit-terminating equipments and between data terminal equipments over the public switched telephone network, which comprises:

A converter to receive a packet data stream intended for a packet domain and to convert the packet data stream into an altered data stream intended for transmission through a public switched telephone network; and

A controller to:

Establish a connection through the public switched telephone network with at least one other network device using the altered data stream;

Send signals through the converter in the altered data stream identifying the network device as a packet device that can receive packet data;

Determine, using signals received from one of the other network devices, whether the other network device is a packet device that can receive packet data;

Send the packet data stream to the other network device, if the network device determines that the other network device is a packet device that can receive packet data;
and

Send the altered data stream to the other network device, if the network device determines that the other network device is not a packet device and cannot receive packet data (Note: the Examiner interprets the claim limitations as relating the negotiation process between data communications devices across a PSTN. The V.8 bis allows the multifunctional terminals to allow a desired communication mode to be selected by either the calling or answering station; allows terminals to automatically identify common operating modes; enables automatic selection between multiple terminals that share a common telephone circuit; and provides user friendly switching from normal voice telephony to a modem-based communication mode. See Appendix I.3-I.6, I.8, and II.1-II.6. Preceding the establishment of a PSTN modem connection across the PSTN the V.8 bis permits the terminals to exchange a list of communication modes. And each terminal is therefore able to establish the modes of operation it shares with the remote station. See Appendix I.4. In this manner, packet data communication can be established between

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packet data peers; otherwise, another mode operation is established between dissimilar peers.)

Regarding claim 23, ITU-T discloses *wherein the network device comprises a voice gateway* (V.8 bis allows the multifunction terminals, modems (voice gateways) to automatically establish operating modes. See Appendix I.2-I.5.)

Regarding claim 24, ITU-T discloses wherein the packet data stream comprises one of either coded voice or data (V.8 bis allows for either voice or data communication. See Appendix I.2-I.5.)

Regarding claims 25 and 29, ITU-T discloses *wherein the converter comprises one of either a voice coder/decoder or modem* (V.8 bis allows the multifunction terminals, modems, to automatically establish operating modes for voice and data communication. See Appendix I.2-I.5.)

Regarding claims 26 and 28, ITU-T discloses *wherein the controller employs one of either ITU V.8 protocols, or robbed-bit signaling to identify the network device as a packet device* (V.8 bis allows the multifunction terminals, modems, to automatically establish operating modes for voice and data communication. See Appendix I.2-I.5.)

Regarding claim 30, ITU-T discloses *gathering information on the other network device and storing the information for further use* (V.8 bis permits each terminal the capability to exchange a list of communication modes and then automatically selects the corresponding mode, requiring data storage for processing. See Appendix I.3-I.5.)

Regarding claim 31, ITU-T discloses *accessing a storage of known network devices based upon the signals received from the other device; locating information about the other*

network device; and using that information in determining whether the other device is a packet device (V.8 bis permits each terminal the capability to exchange a list of communication modes and then automatically selects the corresponding mode, requiring data storage for processing, based upon the configuration of the terminal device. See Appendix I.3-I.5.)

(10) Response to Argument

Issue I

As note on page 5 of the brief, claims 22-31 are grouped together; therefore, the group stands are falls together too.

On page 5 of the brief, regarding claim 22, the Appellant arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the claims avoid such references or objections. However, the Examiner will elaborate on their broad literal reasonable interpretation of the claims (including specific references to the manner in which the ITU-T recommendation discloses the claimed subject matter).

Regarding claim 22, ITU-T discloses: *a converter to receive a packet data stream intended for a packet domain and to convert the packet data stream into an altered data stream intended for transmission through a public switched telephone network.* The ITU-T recommendation discloses the procedures for the identification and selection of common modes (altered data stream) of operation between data circuit-terminating equipments (comprising a converter) and between data terminal equipments (also, comprising a converter) over the public

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switched telephone network for video and audio data (packet data stream) (See Section 5, “Overview of This Recommendation,” and Tables 6-2a, 6-5a, and 6-5b, as well as, Appendix I, section I.1 and I.2.)

The ITU-T recommendation further discloses *a controller*, although not illustrated it is well-known that traditional modems, as referenced by the ITU-T recommendation, comprise a CPU (controller) (See Appendix I, section I.3.) The controller is utilized to *establish a connection through the public switched telephone network with at least one other network device using the altered data stream; send signals through the converter in the altered data stream identifying the network device as a packet device that can receive packet data; determine, using signals received from one of the other network devices, whether the other network device is a packet device that can receive packet data; send the packet data stream to the other network device, if the network device determines that the other network device is a packet device that can receive packet data; and send the altered data stream to the other network device, if the network device determines that the other network device is not a packet device and cannot receive packet data.* The Examiner interprets the claim limitations as relating the negotiation process between data communications devices across a PSTN and their agreed upon communication mode. The ITU-T recommendation discloses that the V.8 bis protocol, via signaling (altered data stream), allows the multifunctional terminals to allow a desired communication mode (establish a connection through the public switched telephone network with at least one other network device using the altered data stream) to be selected by either the calling or answering station; allows terminals to automatically identify common operating modes; enables automatic selection between multiple terminals that share a common telephone circuit (send signals through the

converter in the altered data stream identifying the network device as a packet device that can receive packet data and determine, using signals received from one of the other network devices, whether the other network device is a packet device that can receive packet data); and provides user friendly switching from normal voice telephony to a modem-based communication mode (send the packet data stream to the other network, if the network device determines that the other network device is a packet device that can receive packet data and send the altered data stream to the other network device, if the network device determines that the other network device is not a packet device and cannot receive packet data). See Appendix I.3-I.6, I.8, and II.1-II.6.

Preceding the establishment of a PSTN modem connection across the PSTN the V.8 bis permits the terminals to exchange a list of communication modes (establish a connection utilizing an altered data stream). And each terminal is therefore able to establish the modes of operation it shares with the remote station. See Appendix I.4. In this manner, V.8 bis signaling (altered data stream) establishes a packet data communication connection between packet data peers utilizing their native transmission formats (send packet data stream, unaltered); otherwise, another common mode of operation (send altered data stream) is established between dissimilar peers. See Appendix I.6. Note, the claim does not directly or indirectly state that certain claim elements, such as the converter or controller, are avoided or averted during operation. In regards to the “altered data stream,” the claim does not set forth any functional or structural limitations which would preclude the Examiner's interpretation. Therefore, the ITU-T recommendation, based upon the Examiner's interpretation, discloses claim 22.

Although the Appellant's arguments do not address the manner in which the claim limitations distinguish themselves from the prior art, the Examiner will respectfully address them

too. On page 6 of the brief, regarding claim 22, the Appellant argues, “the instant invention is not directed to modem communications access the PSTN, the instant invention is related to Packet Relay Across Telephone (PRAT).” However, the claim does not specifically recite the term PRAT or include structural and functional limitations exclusive to PRAT. Therefore, the Examiner’s interpretation is not precluded.

On page 6 of the brief, regarding claim 22, the Appellant argues the ITU-T recommendation refers to switching voice calls which are not packet data streams. The Examiner respectfully disagrees. The ITU-T recommendation discloses switching from telephony to data communication. In particular, packet data communication can be established between packet data peers (send packet data stream); otherwise, another mode of operation (send altered data stream) is established between dissimilar peers. See Appendix I.6.

On page 7 of the brief, regarding claim 23, the Appellant argues the ITU-T recommendation does not disclose *wherein the network device comprises a voice gateway*. The Examiner respectfully disagrees. The ITU-T recommendation discloses wherein the V.8 bis protocol allows the multifunction terminals, modems (voice gateways) to automatically establish operating modes. See Appendix I.2-I.6. Therefore, the ITU-T recommendation discloses *wherein the network device comprises a voice gateway*.

On page 7 of the brief, regarding claim 24, the Appellant argues the ITU-T recommendation does not disclose *wherein the packet data stream comprises one of either coded voice or data*. The Examiner respectfully disagrees. ITU-T recommendation discloses wherein the V.8 bis protocol allows for either voice or data communication. See Appendix I.2-I.6.

Therefore, the ITU-T recommendation discloses *wherein the packet data stream comprises one of either coded voice or data*.

On page 7 of the brief, regarding claim 25, the Appellant argues the ITU-T recommendation does not disclose *wherein the converter comprises one of either a voice coder/decoder or modem*. The Examiner respectfully disagrees. The ITU-T recommendation discloses wherein the V.8 bis protocol allows the multifunction terminals, modems, to automatically establish operating modes for voice and data communication. See Appendix I.2-I.6. Therefore, the ITU-T recommendation discloses *wherein the converter comprises one of either a voice coder/decoder or modem*. In addition, the Appellant argues that the ITU-T recommendation does not disclose a network device that has a converter that may be avoided, however, no such claim language can be found in claim 22.

On page 7 of the brief, regarding claim 26, the Appellant argues the ITU-T recommendation does not disclose *wherein the controller employs one of either ITU V.8 protocols, or robbed-bit signaling to identify the network device as a packet device*. The Examiner respectfully disagrees. The ITU-T recommendation discloses wherein the V.8 bis protocol, V.8, allows the multifunction terminals, modems, to automatically establish operating modes for voice and data communication. See Appendix I.2-I.6. In addition, the Appellant argues that the ITU-T recommendation does not disclose a network device that has a controller that can send packet data without using a converter, however, no such claim language can be found in claim 22.

On page 8 of the brief, regarding claim 27, the Appellant argues the ITU-T recommendation does not disclose the elements of claim 27 for the same reasons argued in

regards to claim 22. The Examiner respectfully disagrees for the same reasons stated above in regards to the claim 22.

On page 8 of the brief, regarding claim 28, the Appellant argues the ITU-T recommendation does not disclose the elements of claim 28 for the same reasons argued in regards to claim 26. The Examiner respectfully disagrees for the same reasons stated above in regards to the claim 26.

On page 8 of the brief, regarding claim 29, the Appellant argues the ITU-T recommendation does not disclose the elements of claim 29 for the same reasons argued in regards to claim 25. The Examiner respectfully disagrees for the same reasons stated above in regards to the claim 25.

On page 8 of the brief, regarding claim 30, the Appellant argues the ITU-T recommendation does not disclose *gathering information on the other network device and storing the information for further use*. The Examiner respectfully disagrees. The ITU-T recommendation discloses wherein the V.8 bis protocols permits each terminal the capability to exchange a list of communication modes and then automatically selects the corresponding mode, requiring data storage for processing. See Appendix I.3-I.5. The Examiner equates the realization that a new common mode of communication is required and the subsequent communication in the newly established common mode of communication as *storing the information for further use*. Therefore, the ITU-T recommendation discloses *gathering information on the other network device and storing the information for further use*.

On page 8 of the brief, regarding claim 31, the Appellant argues the ITU-T recommendation does not disclose the elements of claim 31 for the same reasons argued in

regards to claim 30. The Examiner respectfully disagrees for the same reasons stated above in regards to the claim 30.

In summary, the Examiner believes that based upon a broad literal reasonable interpretation (as outlined above in regards to claims 22-31) the ITU-T recommendation discloses the claimed invention. Although the instant invention and prior-art of record are not directed to the exactly the same subject matter, the Appellant has failed to conclusively distinguish their claimed invention from the prior art via structural or functional limitations. In addition, the Appellant alluded to functionality (for example, bypassing the converter) which was not recited in the claim and therefore lacks patentable weight. It appears as though the Appellant has read limitations from the specification into the claims; however, the claims must be read only in light of the specification. For all of the reasons mentioned above, the ITU-T recommendation anticipates the claimed invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Donald L Mills/

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